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10/614,114	07/07/2003	Richard Levy	01064.0011-08-000	7674

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THE LAW OFFICES OF ROBERT J. EICHELBURG  
HODAFEL Building, Suite 200  
196 Acton Road  
Annapolis, MD 21403

EXAMINER
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GRAY, JILL M

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1794

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RICHARD LEVY

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Appeal 2008-2325  
Application 10/614,114  
Technology Center 1700

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Decided:<sup>1</sup> February 27, 2009

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Before CHUNG K. PAK, CHARLES F. WARREN, and  
PETER F. KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary  
Examiner rejecting for at least the second time claims 57 through 63,

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action specified in 37 C.F.R. § 1.304, begins to run from the “Decided” date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

65 through 71, 73, 76, and 87 through 91 in the Office Action mailed August 29, 2006. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We affirm-in-part the decision of the Primary Examiner.

Claim 57 illustrates Appellant's invention of a substrate coated with an essentially water-free composition, and is representative of the claims on appeal:

57. A substrate coated with an essentially water-free composition, wherein said composition comprises a superabsorbent polymer that absorbs greater than 100 times its weight in water in combination with a material for lubricating a surface wherein said material for lubricating a surface comprises:

(1) a lubricating metal and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or

(2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;

(3) said material for lubricating a surface optionally containing a lubricant comprising an organic lubricant, inorganic lubricant, or a lubricant additive;

(4) or a mixture thereof.

The Examiner relies upon the evidence in these references (Ans. 3):<sup>2</sup>

Petinelli	4,621,169	Nov. 4, 1986
Marciano-Agostinelli	5,049,593	Sep. 17, 1991
Freeman	5,218,011	Jun. 8, 1993

Appellant requests review of the following grounds of rejection advanced on appeal (App. Br. 5-6):<sup>3,4</sup>

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<sup>2</sup> We consider these documents: Appeal Brief filed January 10, 2007; Examiner's Answer mailed May 17, 2007; Reply Brief filed July 15, 2007.

<sup>3</sup> The Examiner withdrew the ground of rejection of claims 73 and 76 under 35 U.S.C. § 112, second paragraph. Ans. 2.

claims 57, 65, and 91 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Ans. 4);

claims 57 through 63, 65 through 71, and 87 through 90 under 35 U.S.C. § 102(b) as unpatentable over Freeman (Ans. 6); and

claims 57 through 63, 65 through 71, 73, 76, and 87 through 91 under 35 U.S.C. § 103(a) as unpatentable over Petinelli in view of Freeman and Marciano-Agostinelli (Ans. 7).

Considering first the ground of rejection of claims 57 and 65 under § 112, second paragraph, we agree with Appellant's arguments that the plain language of the claims would specify a material for lubricating a surface that comprises at least the ingredient (1) or (2), and optionally with another ingredient (3), as well as any mixtures of these ingredients. App. Br., e.g., 8. Thus, we disagree with the Examiner position that the language of these claims as a whole, considered in light of the written description in the Specification as it would be interpreted by one of ordinary skill in the art as discussed above, in fact fails sets out and circumscribes the claimed sample processing device with a reasonable degree of precision and particularity. Ans. 4 and 10-12. *See In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971); *see also, e.g., In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994); *The Beachcombers Int'l. v. WildeWood Creative Prods.*, 31 F.3d 1154, 1158 (Fed. Cir. 1994); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).

Accordingly, in the absence of a prima facie case, we reverse the

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<sup>4</sup> Appellant acknowledges these related appeals: Appeal 2008-2981 in Application 08/943,125; Appeal 2009-0443 in Application 09/357,957; and Appeal 2009-0494 in Application 09/359,809. App. Br. 2; Reply Br. 1-2.

ground of rejection of claims 57 and 65 under 35 U.S.C. § 112, second paragraph.

We consider the language of claim 91 as it stands of record as copied at page 3 of the Answer, that includes the phrase “surface comprises” between ingredient (1), which clause reads as in claim 57, and the recitation of lubricating materials falling within the lubricating materials recited in ingredient (1). Appellant states that the recitation of ingredients (1) in claim 91 should include the open-ended term “comprising” at the end thereof and identifies the cited phrase as a typographical error which he will correct. Reply Br. 4-5. We determine claim 91 in the proposed format would satisfy the provisions of § 112, second paragraph. *See* Ans., e.g., 5 and 12-13; Reply Br. 4-5. *See Moore*, 439 F.2d at 1235; *see also, e.g., Warmerdam*, 33 F.3d at 1361; *Beachcombers Int’l.*, 31 F.3d at 1158; *Orthokinetics*, 806 F.2d at 1576.

However, we affirm the ground of rejection of claim 91, as it stands of record, under 35 U.S.C. § 112, second paragraph.

The grounds of rejection under §§ 102(b) and 103(a) turn on whether Freeman would have described a superabsorbent polymer that absorbs greater than 100 times its weight in water to one of ordinary skill in this art. The Examiner contends the superabsorbent material polymers, including commercially available FAVOR C96 disclosed in Freeman “are the same superabsorbent polymers disclosed by applicants [sic] as absorbing greater than 100 times its weight in water.” Ans., e.g., 6, 7-9, 13-14, and 17, citing, e.g., Freeman col. 6, ll. 20-28; col. 10, ll. 32-25, and Examples. Appellant contends the Specification “does not identify FAVOR® C96 as a

superabsorbent polymer having a water absorbency greater than 100, and the manufacture . . . sells many polymers under the FAVOR® brand,” and the Examiner has not established that FAVOR® C96 has the required absorbency. Reply Br. 6.

We find Appellant discloses superabsorbent polymers that absorb “from about 25 to greater than 100 times its weight in water,” and among other things, FAVOR® C, and FAVOR® CA 100. Spec., e.g., 22-25 and Examples.

We agree with Appellant that the Examiner has not established on the record that Freeman would have described a superabsorbent polymer that absorbs greater than 100 times its weight in water to one of ordinary skill in this art. Indeed, we find no evidence in the disclosure in the Specification which establishes that Freeman does so, and the Examiner does not specifically identified any such disclosure.

Accordingly, the evidence of record does not support the Examiner’s conclusions of prima facie anticipation and of prima facie obviousness necessary to establish grounds of rejection under 35 U.S.C. §§ 102(b) and 103(a), and accordingly, we reverse these grounds of rejection. *See, e.g., In re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2007); *In re Spada*, 911 F.2d 705, 707 n.3 (Fed. Cir. 1990).

The Primary Examiner’s decision is affirmed-in-part.

Appeal 2008-2325  
Application 10/614,114

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

PL Initial:  
sld

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